REMARKS

In the Final Office Action mailed August 16, 2005, the Examiner (1) rejected claims 1, 3-4, and 6 under 35 U.S.C. § 103(a) as being unpatentable over *Huffman et al.* (U.S. Patent No. 5,663,748) in view of *Huang* (U.S. Patent No. 6,384,815); and (2) rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over *Huffman* in view of *Huang*, and further in view of *Hastings et al.* (U.S. Patent No. 5,885,012).

By this Amendment, Applicant amends claims 1-6 to better define the claimed invention and adds new claims 7-10. Claims 1-10 are pending. Of these claims, claims 1 and 4 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1-6 and the addition of new claims 7-10. No new matter has been introduced.

Applicant traverses each of the above rejections and respectfully requests reconsideration for at least the reasons that follow.

Applicant respectfully submits that independent claims 1 and 4 patentably distinguish over *Huffman*, *Huang*, *Hastings*, and the other art of record, at least for the reasons described below.

Huffman discloses an electrical book. If a user-initiated event marking a portion of the text is performed, as indicated by block 454, a step of displaying an option selection dialog box is performed, as indicated by block 456. The option selection dialog box provides a plurality of options including a highlighting option. (*Huffman*, col. 17, line 62 - col. 18, line 11 and Figure 27). As admitted by the Examiner, *Huffman* is

silent at least as to "selecting the range and marking text in a single-step action." (*Office Action*, p. 3, ll. 3-6). In addition, *Huffman* does not differentiate between marking different positions of the text to display different options. For example, *Huffman* does not suggest providing a highlighting option if a lower edge part of the text is marked and providing an underlining option if a center part of the text is marked.

Huffman fails to teach or suggest the claimed combination including at least "determining, based upon a single-step selection technique for specifying one of the multiple elements, a type of mark to emphasize a specified element;...wherein a first position of the specified element traced by the user displays a first type of mark onto the specified element; and wherein a second position of the specified element traced by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark," as recited in amended claims 1 and 4.

To cure the deficiencies of *Huffman*, the Examiner relies on *Huang* for its asserted disclosure of an "electronic text highlighting technique which selects an area of characters of the display touched by the user and marks the text in a single step." (*Office Action*, p. 3, ll. 6-8). *Huang* discloses an automatic selection method that analyzes the shape of each pen stroke. "More specifically, the length of each pen stroke is calculated between its starting and a later made point." (*Huang*, col. 2, ll. 31-34). Accordingly, a type of mark displayed on a specified element is not controlled by a position of the specified element traced by a user (emphasis added). For example, *Huang* does not suggest providing a highlighting mark if a lower edge part of a specified element is traced and providing an underlining mark if a center part of a specified element is traced.

Huang does not teach or suggest, among other things, "wherein a first position of the specified element traced by the user displays a first type of mark onto the specified element; and wherein a second position of the specified element traced by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark," as recited in amended claims 1 and 4. Consequently, Applicant respectfully requests that the rejection of claims 1 and 4 under 35 U.S.C. §103(a) be withdrawn.

Moreover, claims 2, 3, 7, and 8 are allowable at least due to their direct dependence from independent claim 1, and claims 5, 6, 9, and 10 are allowable at least due to their direct dependence from independent claim 4. In addition, each of the dependent claims recites unique combinations that are neither disclosed nor suggested by the cited art, and therefore each also are separately patentable.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-10 in condition for allowance. Applicant submits that the proposed amendments of claims 1-6 and the addition of new claims 7-10 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment

would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: _____
Michael R. Kelly
Reg. No. 33,921